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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,760	03/23/2001	Alan Derek Dean	52308-1190	7939
24504	7590	06/16/2004	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			PATEL, HARESH N	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,760

Applicant(s)

DEAN, ALAN DEREK

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 are presented for examination.

Priority

2. Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) or (f), is acknowledged.

Specification

3. The disclosure is objected. Some of the informalities are:
 - i. The section "CROSS-REFERENCE TO RELATED APPLICATIONS" is missing claimed priority information.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "System for constructing a set of standardized electronic mail addresses containing user specific information".

Drawings

5. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. E-mail index search graphical user interface and supporting search database components is well known in the prior art, for example, Administrators using Microsoft Outlook 97, Schedule+ program and supporting

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databases. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

6. An initialed and dated copy of Applicant's IDS form 1449, paper dated, 12/22/2003, is attached to the instant Office action.

Claim Objections

7. Claims 1 and 2 are objected to because of the following informalities:

Claims 1 and 2 mentions term "standardised", which is incorrect. It should be "standardized".

Claims 4 and 10 mentions term "each individual in a country", which is incorrect. It should be "individual's country.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-12 are software per se that is not tangibly embodied on a computer readable medium and therefore lacks a practical application because it alone cannot produce its intended outcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu et al. 6,125,369 (Hereinafter Wu).

12. As per claims 1 and 7, Wu teaches the following:

a method/system of generating a set of standardized electronic mail addresses
(e.g., configuration of plurality of properties and addresses of Microsoft 97, inherent use

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of e-mail addresses, creation/setting/update of uniform properties of address for plurality of users, col., 3, lines 31 – 41),

including providing a personal name code indicative of the name of a person (e.g., a name of user, col., 18, lines 33 – 39), providing a location code indicative of a known location of the person (e.g., street address, city, state, zip code, etc., col., 18, lines 33 – 39),

generating an electronic mail address for said person based on said personal name code and said location code (e.g., creation of database entry containing user specific parameters for a user, col., 17, line 20 – col., 18, line 63, col., 20, lines 8 – 57), and

providing a database of said electronic mail addresses for a plurality of persons at one or more locations (e.g., user specific email address information available from a primary computer or a portable computer, abstract).

13. As per claims 2-6 and 8-12, Wu teaches the following:

the location code is a postal or area code, a telephone area code (e.g., street address, col., 18, lines 33 – 39),

the personal name code preferably includes at least a person's family name (e.g., name of the user, col., 18, lines 33 – 39),

one or more structured addresses are created for each individual in a country, geographic region or state (e.g., city, col., 18, lines 33 – 39),

one or more subsidiary addresses, including existing electronic addresses, are attached to an individual's electronic mail address in the database (e.g., updating of

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address information containing other email address from object store related to the user, col., 15, lines 7 – 63),

attaching a unique identifier to an individual's electronic mail address (e.g., use of unique object identifier, col., 6, lines 40 – 53).

Conclusion

14. Examiner makes a very clear note that the rational of the applicant's invention is clearly taught by well-known use of Microsoft Outlook 97, Schedule+ program and supporting databases. Applicant's invention does contain few minor additional matters that facilitate the concepts of the applicant's invention. However, the additional minor matters are well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100